

I. REMARKS

Upon entry of the foregoing amendment, claims 1-9, 11-15 and 17-21 and 25-27 are pending in the present application. Claims 10, 16 and 22-24 are cancelled. Claims 19-21 and 25-27 stand withdrawn.

Claims 1 and 15 are currently amended. Basis for the amendments to claims 1 and 15 may be found at page 4, 3rd paragraph of the present specification. Claims 10 has been canceled solely to advance prosecution. Applicant, by canceling or amending any claims herein, makes no admission as to the validity of any rejection made by the Examiner against any of these claims. Applicant reserves the right to reassert any of the claims canceled herein or the original claim scope of any claim amended herein, in a continuing application. It is believed this amendment does not introduce new matter and entry is respectfully requested.

II. OBJECTION TO CLAIM 10

At page 2 of the Official Action, the Examiner has objected to claim 10 for allegedly not limiting the claims from which it depends. Applicant respectfully traverses. However, solely to advance the prosecution of this application, applicants have canceled claim 10.

Accordingly, applicant respectfully requests that the Examiner reconsider and withdraw this objection to claim 10.

III. REJECTION OF CLAIMS 1-15, 17 AND 18 UNDER 35 USC § 103(a)

At page 3 of the Official Action, the Examiner has rejected claims 1-15, 17 and 18 under 35 USC § 103(a) as being unpatentable over Amschler (WO98/09982).

The rejection is respectfully traversed. The Examiner has not established a *prima facie* case of obviousness against the presently pending claims.

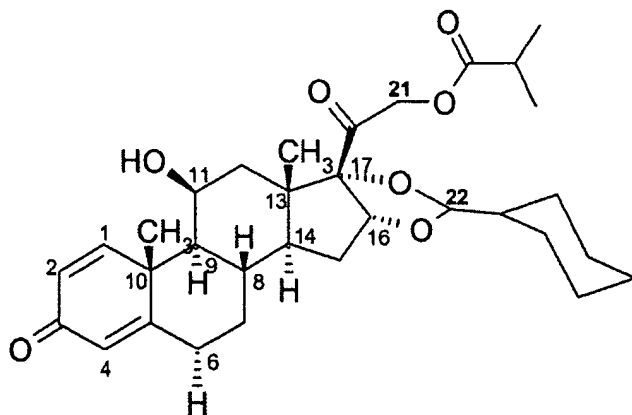
To establish a *prima facie* case of obviousness, the PTO must satisfy three requirements. First, there must be some motivation or teaching in the references cited by the Examiner to combine the separate elements taught in the separate references. As the U.S. Supreme Court held in *KSR International Co. v. Teleflex Inc. et al.*, 550 U.S. 398 (2007), “a court must ask whether the improvement is more than the predictable use of prior art elements according to their established functions. ...it [may] be necessary for a court to look to interrelated teachings of multiple patents; the effects of demands known to the design community or present in the marketplace; and the background knowledge possessed by a person having ordinary skill in the art, all in order to determine whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue. ...it can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does... because inventions in most, if not all, instances rely upon building blocks long since uncovered, and claimed discoveries almost of necessity

will be combinations of what, in some sense, is already known.” See *KSR International Co. v. Teleflex Inc. et al.*, 550 U.S. 398 at 417-418. Second, the proposed modification of the prior art must have had a reasonable expectation of success, determined from the vantage point of the skilled artisan at the time the invention was made. *Amgen Inc. v. Chugai Pharm. Co.*, 18 USPQ2d 1016, 1023 (Fed. Cir. 1991). Lastly, the prior art references must teach or suggest all the limitations of the claims. *In re Wilson*, 165 USPQ 494, 496 (C.C.P.A. 1970).

The Examiner alleges at pages 3-4 of the Official Action that applicants previous amendment into claim 1 of “a particle diameter for 50% of the total volume of all particles (X_{50}) of less than or equal to $3\mu\text{m}$ ” represents the intended result of process steps positively recited, and as such is of no consequence in the construction of the claim for the purposes of examination. Nevertheless, assuming arguendo that the additional claim language does present an affirmative limitation, the examiner asserts that the particle size put forth in the instant claims would necessarily result from merely following the process steps as set forth. ... Where, as here, applicants invention as claimed represents merely the rearrangement of known process steps, and the substitution of one solvent well known for the purposes of recrystallizing organic chemical compounds, without appropriate evidence of secondary indicia of nonobviousness commensurate in scope with the invention as claimed, the claimed invention is obvious.”

To address the Examiner’s concern that the claim amendments introduced in

In particular, presently pending independent claim 1 is directed to a process for preparing a compound of the formula I



Formula I

a) preparing a solution of the compound of the formula I in a suitable water-miscible organic solvent;

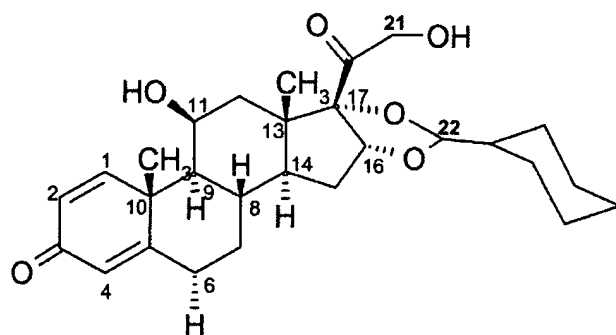
b) adding the solution obtained in a) to water and

c) isolating a precipitate with a particle diameter for 50% of the total volume of all particles (X_{50}) of less than or equal to $3\mu\text{m}$ of the compound of

the formula I which is formed.

Presently pending claim 15 is directed to a process for preparing a compound of the formula I according to Claim 1 in crystalline form with defined particle size, comprising the steps of

- a) preparing a compound of the formula I by acylation of a compound of the formula II



Formula II

with a suitable acylating agent;

- b) crystallizing the compound of the formula I obtained in a) by adding water to a solution of the compound in a suitable water-miscible organic solvent or heating a suspension of the compound of the formula I in a mixture of a suitable water-miscible organic solvent and water,
- c) removing the resulting R epimer-enriched precipitate of the compound of the formula I from the water/solvent mixture;
- d) if desired repeating step b);
- e) preparing a solution of the compound obtained in c) in a suitable water-

miscible organic solvent;

- f) adding the solution obtained in e) to water and
- g) isolating a precipitate with a particle diameter for 50% of the total volume of all particles (X_{50}) of less than or equal to $3\mu\text{m}$ which has been formed of the compound of the formula I.

Accordingly, the limitation “a particle diameter for 50% of the total volume of all particles (X_{50}) of less than or equal to $3\mu\text{m}$ ” is clearly an affirmative limitation on each of these claims as this language occurs in an active process step of isolating a precipitate with these characteristics.

Regarding the Examiner's assertion that “without appropriate evidence of secondary indicia of nonobviousness... the claimed invention is obvious”, applicants again point to the data contained in the instant specification. Despite clear evidence to the contrary contained in applicant's disclosure, the Examiner has alleged that the '982 publication would make the claimed process obvious under 35 U.S.C. §103(a).

In this regard, applicant respectfully directs the Examiner's attention to page 11 of the instant specification, Example 3. In Example 3, applicant has clearly indicated that the process disclosed in the '982 publication yields much higher X_{50} values than those presently claimed. In particular, Examples 1-6 (listed under Example 3) all yield X_{50} values over $20\mu\text{m}$. Applicant further respectfully directs the

Examiner's attention to the last sentence of Example 3 which states that such X_{50} values "are not in the range of X_{50} values of particle sizes suitable for inhalation." As such, the '982 publication teaches away from the presently pending claims. Further, applicant respectfully notes that the '982 publication has no teaching whatsoever regarding how to arrive at the presently claimed particle diameter.

As such, the '982 publication cannot possibly render the presently claimed process obvious. Accordingly, the presently rejected claims are unobvious over the cited Amschler reference and withdrawal of this rejection is respectfully requested.

IV. REQUEST FOR REJOINDER OF WITHDRAWN CLAIMS

Applicants believe that, in view of the amendments and remarks presented herein, elected and pending claims 1-9, 11-15 and 17-18 are allowable over the prior art of record.

Accordingly, applicants respectfully request rejoinder of non-elected claims 19-21 and 25-27 because they "depend from or otherwise require all the limitations of" the allowable claims. MPEP §821.04 states the following, in relevant part:

"The propriety of a restriction requirement should be reconsidered when all the claims directed to the elected invention are in condition for allowance, and the nonelected invention(s) should be considered for rejoinder..... In order to be eligible for rejoinder, a claim to a nonelected invention must depend from or otherwise require all the limitations of an allowable claim."

In this regard, applicants respectfully note that claims 22-24 have been canceled as they did not require any process limitations in accordance with any of the presently allowable process claims. Accordingly, because withdrawn claims 19-21 and 25-27 now "depend from or otherwise require all the limitations of" the allowable claims, applicants respectfully request that the Examiner now rejoin these claims into the present application.

V. CONCLUSION

Applicant asserts that the claims are in condition for immediate allowance and early notice to that effect is earnestly solicited. Should the Examiner deem that any further action by Applicant's undersigned representative is desirable and/or necessary, the Examiner is invited to telephone the undersigned at the number set forth below.

In the event this paper is not timely filed, Applicant petitions for an appropriate extension of time. Please charge any fee deficiency or credit any overpayment to Deposit Account No. 14-0112.

Respectfully submitted,

THE NATH LAW GROUP

A handwritten signature in black ink, appearing to read 'Joshua B. Goldberg', is written over a horizontal line.

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Date: March 29, 2010
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